

REMARKS

The final Office Action of January 26, 2004 has been received and reviewed. The Applicant wishes to thank the Examiner for the courtesies extended to the Applicant, Larry Glaser and his representatives, David May and Jerry Massie, during the telephone interview of March 30, 2004. The issues raised and discussed during the telephone interview are set forth below in the context of a rebuttal of the currently outstanding rejections of the claims.

Prior to this Office Action, claims 1-22 were pending in the application, of which claims 1 and 20 are independent. By the above actions, independent claims 1 and 20 have been amended in a manner deemed by the Examiner during the telephone interview as distinguishable over the cited prior art references, and new claims 23 and 24 have been added to further include the features deemed distinguishing over the cited prior art references as discussed during the interview. Therefore, claims 1-24 are pending with claims 1, 20 and 24 being independent.

In the January 26th Office Action, claims 1-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 96/24213 A1 of Goldschmitt (hereinafter "Goldschmitt"), in view of U.S. Patent No. 6,029,141 to Bezos et al. (hereinafter "Bezos"). In light of the amendment above and for the reasons discussed below, Applicant respectfully submits that the disclosures of these references do not present a *prima facie* case of obviousness.

In the Office Action, the Examiner states that "Bezos discloses embedding an advertisement within communication and associating within the user-managed data processing system (i.e. can disseminate catalogs. . .e-mail newsletters. . .that include the associate's reviews and/or recommendations on specific products sold by the merchant). However, amended claim 1 of the application is directed to a method of transmitting an advertisement from a sending party to a receiving party comprising the steps of (1) initiating a communication from a data processing system of a sending

party by the sending party; (2) associating at least one pre-selected advertisement with said communication within the data processing system of the sending party; and (3) transmitting said communication with said at least one advertisement embedded therein to the recipient, wherein the at least one advertisement optionally includes a hyperlink. Support for the amendment of claim 1 can be found at least in, e.g., line 7 from the bottom of page 11 of the specification.

The Examiner cited Col. 1, lines 50-61 of Bezos as disclosing embedding advertisement within a communication. However, the cited text in Bezos discloses a software system and method for enabling an Internet sales merchant, to market and sell goods in cooperation with Web sites or other networks sites of respective business partners, referred to as “associates.” The merchant can enroll as an associate, and can disseminate catalogs (web documents, PUSH documents, e-mail newsletters, etc.) that include the associate’s reviews and/or recommendations on specific products sold by the merchant. The associate catalog documents include product-specific hyperlinks (i.e., referral links), defined as a navigational link from one document to another, or from one portion of a document to another. Unlike the present invention of claim 1, however, the disseminated catalogs do not have advertisements embedded therein.

In other words, contrary to the Examiner’s understanding, Bezos does not teach the association of advertisements in a communication and transmitting the communicating with the embedded advertisement to a recipient. Instead, as disclosed by Bezos, an “associate” web site provides a hypertextual “referral link” that allows a customer visiting the associate’s web site to link to the merchant’s web site by clicking on a “referral link” to initiate purchases of products from the merchant, which subsequently allows the merchant to identify the product and its referring associate.

According to the Interview Summary dated March 30, 2004, the Examiner acknowledged and agreed that the advertisement in Bezos is a hyperlinked document itself, whereas the embedded advertisement in the presently claimed invention can include a hyperlink. Accordingly, claim 1 of the present invention has been amended,

as shown above, to provide distinction between an advertisement and a hyperlink. According to amended claim 1, an embedded advertisement may, i.e., optionally, include a hyperlink. Applicant respectfully submits that there is no such distinction between a hyperlink and an advertisement disclosed or suggested by Bezos.

Further, as summarized and acknowledged by the Examiner in the Interview Summary dated March 30, 2004, the advertisement in Bezos is under control of a third party and not under the local control of the sending party. That is, a user or customer has no control of the display or promotion of the products offered by the merchant or its associates. Accordingly, Applicant has added new dependent claim 23 and independent claim 24 directed to the feature wherein the pre-selected advertisement is under the local control of the sending party so as to be in accordance with the discussion during the interview and to further distinguish the presently claimed invention over Bezos.

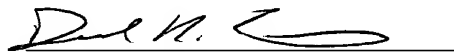
As set forth above, Bezos' internet-based customer referral system is clearly different from the method of transmitting a communication including an advertisement of the presently claimed invention.

With respect to the §103(a) rejection of independent claim 20 over Goldschmitt, Bezos and Uomini, claim 20 has also been amended to recite "the at least one advertisement optionally includes a hyperlink". Hence, the arguments set forth above in regard to Bezos and the rejection of claim 1 are also applicable. Since each feature of the presently claimed invention is not taught or suggested, by the combination of the Goldschmitt, Bezos and Uomini references, and since neither reference or the Examiner provides any motivation to modify the teachings of Goldschmitt to provide the features of the claims as instantly presented, a *prima facie* case of obviousness has not been established by the combined teachings of Goldschmitt, Bezos and Uomini. Consequently, the § 103(a) rejections of claims 1-22 are also not appropriate and must now be withdrawn.

In view of the arguments and amendments set forth above, the allowance of claims 1-22 and new claims 23-24 is respectfully requested.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,



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